

REMARKSRejection of Claims 13, 14, 15, 18 and 20 Under §103(a)

Claims 13, 14, 15, 18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Eilers *et al.* (1991. *EMBO J.*, 10:133-141; Reference AU) in view of Adnane *et al.* (1995. *Oncogene*, 10:381-387).

Applicants respectfully traverse this rejection. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." (MPEP, 2143.01). In the absence of an express motivation to combine the references contained in the references themselves, the Examiner offers the following:

One of ordinary skill in the art would have been motivated to create the new method of identifying agents which modulate MYC transcriptional activity because the method of Eilers does not use an artificial reporter construct to indicate MYC transcriptional activity, but rather indicates MYC transcriptional activity by assaying actual genes that are directly regulated by MYC, thus making the new method an improved system for testing regulators of MYC transcriptional activity. Page 4 of the Office Action.

Applicants respectfully disagree. The Examiner's position appears to be that an assay utilizing a direct measurement of a MYC-regulated gene, instead of an artificial construct, would provide one of skill in the art with a better method for identifying an agent that regulates MYC activity, thereby providing motivation to modify or combine the teachings of the cited references. Applicants direct the Examiner's attention to the fact that the Eilers *et al.* reference was publically available at the time the Adnane *et al.* work was performed, and Eilers *et al.* describe the detection of MYC-regulated gene products by detecting mRNA expression levels. Therefore, this reference and others describing MYC-regulated genes were available to Adnane *et al.* at the time they tested Rb for its potential interaction with MYC. Indeed, MYC target genes in addition

to that taught by Eilers *et al.* had been identified at that time (Bello-Fernandez, C. *et al.*, 1993. *Proc. Natl. Acad. Sci. USA*, 90:7804-7808 (Reference AR); Klefstrom, J. *et al.*, 1994. *EMBO J.*, 13:5442-5450 (Reference AW2)), yet Adnane *et al.* chose to identify an agent that regulates MYC activity using the artificial CAT construct.

Even though MYC-regulated genes had been identified several years prior to the publication of Adnane *et al.*, Adnane *et al.* nevertheless chose a CAT reporter system to identify an agent that regulates MYC activity. This choice clearly indicates that the Examiner's statement that detection of genes that are "directly regulated" by MYC represents an "improved system" for detecting regulators of MYC is not supported by the cited art. Indeed, use of an artificial reporter construct and detecting physiological targets of MYC both offer certain advantages and disadvantages for a researcher. Therefore, one of skill in the art would choose the method better suited to the particular needs of the experiment. In the case of Adnane *et al.*, the choice to detect the effect of an agent by detecting MYC-regulated expression of an artificial reporter construct reflects the fact that Adnane *et al.* viewed this as the better method for their objectives.

Since Adnane *et al.* acknowledge that specific targets for MYC were known (Adnane *et al.*, page 381, second column), it is clear that detection of natural MYC targets to evaluate the effectiveness of an agent that regulates MYC activity did not represent a better method for the purpose of Adnane *et al.* Therefore, it is clear that, contrary to the Examiner's assertion that motivation to combine the teachings of Eilers *et al.* with the teachings of Adnane *et al.* derives from the fact that one of skill in the art would recognize a better method for testing regulators of MYC, there is no such improvement recognized in the cited art. Indeed, Adnane *et al.* chose the method of identifying regulators of MYC activity that was best suited to the objectives of the work described in the Adnane *et al.* reference, and this was not the method taught by Eilers *et al.*

Therefore, because the teachings of Eilers *et al.* would not have been recognized as a better method for identifying regulators of MYC activity by those of skill in the art, there was no motivation to combine the teachings of Eilers *et al.* with the teachings of Adnane *et al.* Therefore, Applicants' claimed invention is not rendered obvious by the cited art. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claim 17 Under §103(a)

Claim 17 is rejected under 35 U.S.C. §103(a) as being obvious in view of Eilers *et al.* (1991. *EMBO J.*, 10:133-141; Reference AU), Adnane *et al.* (1995. *Oncogene*, 10:381-387) and further in view of Lee *et al.* (1997. *Proc Natl. Acad. Sci. USA*, 94:12886-12891).

Applicants respectfully traverse this rejection because there was no motivation to combine the teachings of Eilers *et al.* and Adnane *et al.*, as described above. The teachings of Lee *et al.* do not remedy this defect and offer no express or implied motivation to combine the teachings of Eilers *et al.* with the teachings of Adnane *et al.* Therefore, Applicants' claimed invention is not rendered obvious by the cited art. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 16 and 19 Under §103(a)

Claims 16 and 19 are rejected under 35 U.S.C. §103(a) as being anticipated by Eilers *et al.* (1991. *EMBO J.*, 10:133-141; Reference AU) in view of Adnane *et al.* (1995. *Oncogene*, 10:381-387) and further in view of Zhu *et al.* (1998. *Proc Natl. Acad. Sci. USA*, 95:14470-14475).

Applicants respectfully traverse this rejection because there was no motivation to combine the teachings of Eilers *et al.* and Adnane *et al.*, as described above. The teachings of Zhu *et al.* do not remedy this defect and offer no express or implied motivation to combine the teachings of Eilers *et al.* with the teachings of Adnane *et al.* Therefore, Applicants' claimed invention is not rendered obvious by the cited art. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the above remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

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